

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of

Thomas W. Smith et al.

Application No.: 10/036,590

Examiner: C. Shosho

Filed: November 7, 2001

Attorney Docket No.: A1503-US-NP

For: INK COMPOSITIONS WITH IMPROVED LIGHTFASTNESS

REPLY BRIEF

Appeal from Group Art Unit 1714

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Application No. 10/036,590

This Reply Brief is filed in response to the Examiner's Answer mailed April 25, 2005 in the above identified application.

I.

The Examiner has stated on page 11 of the Examiner's Answer that the combination of Gundlach et al. with either Vieira et al., Yokoyama et al., Bergthaller et al., or Ma et al. would produce a complex of (i) anionic dye, (ii) anionic lightfastness-imparting agent, and (iii) polyquaternary amine compound as presently claimed, and states that evidence to support this position is found in the examples of the present specification. More specifically, the Examiner is of the position that, based on the examples of the present specification, it is clear that such combination of polyquaternary amine/anionic dye complex with anionic lightfastness imparting agent would intrinsically result in the formation of a complex of (i) anionic dye, (ii) anionic lightfastness-imparting agent, and (iii) polyquaternary amine compound as presently claimed.

This argument presents a classic example of the use of hindsight in piecing together prior art references using the benefit of the teachings of the present application to arrive at the present invention. Such a practice is forbidden when considering obviousness. Using hindsight or applying the benefit of the teachings of the present application when determining obviousness is impermissible; the references applied must be reviewed without hindsight, must be reviewed as a whole, and must suggest the desirability of combining the references. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984). One must avoid reading the applicant's statements into the prior art, and must determine if the prior art, without the benefit of the applicant's disclosures, would make the invention as a whole obvious. In re Sponnoble, 160 U.S.P.Q. 237 (CCPA 1969). When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroyal Inc. v. Rudkin Wiley Corp., __ F. 2d __, 5 U.S.P.Q. 2d 1435 (Fed. Cir.

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1988); Interconnect Planning Corp. v. Fell, 774 F. 2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention. Uniroyal Inc. v. Rudkin Wiley Corp., ___ F. 2d ___, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F. 2d 1640, 220 U.S.P.Q. 303 (Fed. Cir. 1983). The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. In re Dow Chemical, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). The Examiner is using Appellants' disclosure as a recipe for selecting the appropriate portions of the prior art to construct Appellants' ink. A piecemeal reconstruction of the prior art patents in light of Appellants' disclosure is not a basis for a holding of obviousness. In re Kamm et al., 172 U.S.P.Q. 298 (C.C.P.A. 1972). For the instant application, the Examiner also appears to have attempted to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. This method is clearly impermissible.

II.

On pages 16 and 17 of the Examiner's Answer, the Examiner has disputed Appellants' previous arguments to the effect that the Examiner has used an "obvious to try" standard of obviousness against the instant invention, stating that the references were combined given that there is motivation for one of ordinary skill in the art to combine Vieira et al., Yokoyama et al., Bergthaller et al., or Ma et al. with Gundlach et al., namely the use of anionic lightfastness agents to improve the colorfastness or lightfastness of the ink.

Appellants are of the position that one of ordinary skill in the art would not have known what would happen when the elements of the instant invention were combined. The Examiner has used the working

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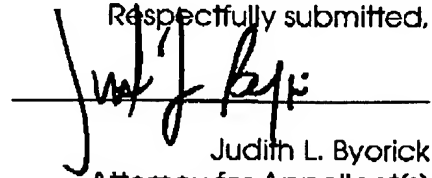
examples of the present specification as evidence in favor of obviousness, but these examples were not available to one of ordinary skill in the art at the time the invention was made and are not proper for consideration. As stated in the present specification,

It is believed that incorporation of anionic lightfastness agents in accordance with the teachings of this invention promote the lightfastness of ternary mixtures of an anionic lightfastness-imparting agent and anionic dye in association with a polyquaternary amine compound by separating the dye molecules associated with the anionic polymer with anionic reagents that can actively interact with photoexcited dye molecules to promote non-destructive recombination of photoexcited anionic radicals and intercept destructive free-radical intermediates.

Contrary to the Examiner's assertions, one of ordinary skill could not have known with any reasonable degree of certainty what would happen when the elements of the present invention were combined. Accordingly, Appellants maintain that the Examiner's position remains, at best, an "obvious to try" argument.

For the reasons set forth herein and in the Appeal Brief, Appellants are of the position that the appealed claims of the present application are patentable with respect to the prior art cited by the Examiner, and accordingly respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of the claims.

Respectfully submitted,


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